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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,361	07/10/2000	Jay S. Walker	96-140-C1	9450
22927 7590 05/12/2008 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER COLBERT, ELLA				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/613,361

**Applicant(s)**

WALKER ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3696

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 70-79 and 81-91 is/are pending in the application.
- 4a) Of the above claim(s) 81-91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 70-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 70-79 and 81-91 are pending. Group I, claims 70-79 have been elected and claims 81-91 have been cancelled without traverse in response to the Restriction filed 2/04/08. Claims 70-79 will be examined on the merits as set forth here below.

#### ***Claim Objections***

Claims 70, 73, 76, 77, 78, and 79 are objected to because of the following informalities: Claims 70, 71, 72, 76 and 78 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 73, 74, 75, 77, and 79. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). .  
Appropriate correction is required.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 70 and 73 are provisionally rejected on the ground of nonstatutory double patenting over claim 1 of copending Application No. 11/423,161. Although the conflicting claims are not identical they are not patentably distinct from each other because the instant claimed invention is a narrower recitation of the '161 application. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The 11/423,161 application claims i) "A method for issuing a gift certificate corresponding to a financial account, comprising the steps of: identifying and accessing stored account data associated with a financial account, said stored data including an account identifier; determining a certificate identifier corresponding to said account identifier; producing a gift certificate including thereon said certificate identifier; and distributing said gift certificate to an owner of said financial account."

Wherein the instant application the Applicants' claim: Claim "A method comprising: generating, by a computer, a certificate identifier linked to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier; producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier; and distributing said gift

certificate to an owner of said financial account" and claim 73. "A method comprising : generating, by a computer, a certificate identifier corresponding linked to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier; producing a gift certificate including thereon said certificate identifier, said gift certificate not including said account identifier; and distributing said gift certificate to a recipient."

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 70-79 are rejected under 35 U.S.C. 102(a) as being anticipated by (US 5,870,718) Spector.

Claim 70. Spector discloses, A method comprising: generating, by a computer, a certificate identifier linked to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier (col. 4, lines

14-21); producing a gift certificate including thereon said certificate identifier (Fig. 2 (CS) –shows this element), said gift certificate not including said account identifier (Fig. 2 (CS) –shows this element); and distributing said gift certificate to an owner of said financial account (col. 2, lines 20-28).

Claim 71. Spector discloses, The method of claim 70 wherein the financial account identifier cannot be discerned from the gift certificate identifier by a third party (col. 4, 14-23).

Claim 72. Spector does not expressly disclose, The method of claim 70, further including the steps of: receiving an indication of a gift certificate redemption; and updating stored account data to reflect the redemption. However, these steps would be inherent to receive some type of indication that the gift certificate has been redeemed and the stored account data would automatically be updated to reflect the amount of the redemption.

Claim 73. Spector discloses, A method comprising: generating, by a computer, a certificate identifier corresponding linked to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier (col. 4, lines 14-21); producing a gift certificate including thereon said certificate identifier (Fig. 2 (CS) –shows this element), said gift certificate not including said account identifier (Fig. 2 (CS) –shows this element), said gift certificate not including said account identifier; and distributing said gift certificate to a recipient (col. 2, lines 20-28 and (col. 3, lines 44-48).

Claim 74. Spector discloses, The method of claim 73 wherein the financial account

identifier cannot be discerned from the gift certificate identifier by a third party (col. 4, lines 14-23).

Claim 75. Spector did not expressly disclose, The method of claim 73, further including the steps of: receiving an indication of a gift certificate redemption; and updating stored account data to reflect the redemption. However, these steps would be inherent to receive some type of indication that the gift certificate has been redeemed and the stored account data would automatically be updated to reflect the amount of the redemption.

Claim 76. Spector discloses, A system comprising: computer (col. 3, lines 49-53) means for generating a certificate identifier linked to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier (col. 4, lines 14-21); means for producing a gift certificate including thereon said certificate identifier (Fig. 2 (CS)- shows this element), said gift certificate not including said account identifier (Fig. 2 (CS)- shows this element), and means for distributing said gift certificate to an owner of said financial account (col. 2, lines 20-28).

Claim 77. Spector discloses, means for distributing said gift certificate to a recipient (col. 3, lines 44-48). This independent claim is rejected for the similar rationale as given above for claim 73.

Claim 78. This independent claim is rejected for the similar rationale as given above for claims 70 and 76.

Claim 79. This independent claim is rejected for the similar rationale as given above for

claims 73 and 77.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hayashi (US 4,809,837) disclosed a vending machine with a gift certificate with information for identifying a total face value.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

May 12, 2008